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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,427	03/28/2001	Veronica A. Nelson	10992847-1	5669

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

HSIEH, SHIH WEN

ART UNIT	PAPER NUMBER
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2861

DATE MAILED: 08/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/820,427

Applicant(s)

NELSON ET AL.

Examiner

Shih-wen Hsieh

Art Unit

2861

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED ~~8-11-03~~ FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 5-14, 20 and 21.Claim(s) objected to: 4, 16 and 17.Claim(s) rejected: 1-3, 15, 18, 19, 22-24.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

S. Hsieh 8-21-03
Shih-wen Hsieh
Primary Examiner
Art Unit: 2861

Continuation of 5. does NOT place the application in condition for allowance because: Applicants' arguments are not persuasive. Because: 1) the motivation of using Sneed reference is its humidity resistant polyester material used in ink-jet film. The limitation of the instant application is the base is "moisture resistant". Therefore, the task is to find a material that is moisture resistant, and the result is Sneed's polyester is a humidity resistant material. 2) It is a non-analogous art as Applicants argued, however, Examiner contends that it is a pertinent/relevant art, because it teaches a humidity resistant polyester. 3) As the Applicants also argued that among a wide different types of polyester films, why Examiner selected the particular humidity resistant polyester film taught by Sneed. Examiner contends the reason of selecting Sneed polyester is obvious, because among polyesters, Sneed's polyester is humidity resistant. 4) For claim 2, this claim is actually a selection of material. Iwasaki's base material is made of polyolefin, which is moisture resistant material. To respond to this argument in another way, Examiner's answer is still going back to the discussion above, i.e., selection among a wide different types of materials, and Iwasaki's polyolefin is the one meets moisture resistant's limitation. 5) For claim 19, Examiner's answer is the same as those given to claim 2, or basically, claim 19 is also a selection of moisture resistant material, however, in claim 19, a pouch material is being proposed. 6) For claims 4 and 17 (claim 8 is allowed, because claim 6 is allowed and claim 8 depends on claim 6), Examiner has indicated them as allowable subject matters. 7) For claims 22-24, Examiner acknowledged these three claims have been amended to three different materials, obviating those trade names. However, these three claims are still a selection of materials for the moisture resistant material base film and Examiner's answer is still the same as those discussed above. Applicants argue that Examiner engaged in hindsight reconstruction of the claimed invention, in response to applicants' argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgement on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from Applicants' disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Also please note that claim 6 was allowed in office action dated Dec. 26, 2002. The reason for allowance is due to the amendment to claim 6 in amendment dated Oct. 15, 2002. The original form of claim 6 (unamended) presented in amendment after final dated Aug. 11, 2003 is not correct. If claims 6 and its dependent claims 7-14 are to be issued, claim 6 has to be in the form as it was presented in amendment dated Oct. 15, 2002. Please be advised.